discussion purposes, and for review by the Examiner's supervisor following the telephone interview.

As amended, Claim 1 is directed to automatically generating claim breadth metrics for multiple claims from multiple patents. Automatic generation is useful, for example, when dealing with hundreds or thousands of patents, such as when examining companies' large patent portfolios. The generated claim breadth metric provides an indication of how broad or narrow a claim is. The claim breadth metric is very different that what the primary reference cited against us (i.e., USPN 6,038,561 known as the "Snyder" reference) discloses. The Snyder reference compares two patents together to see if they are similar. For example, the Snyder summary describes at column 4, lines 53-62: "Thus, a kind of 'cross-comparison' matching is used, wherein the combined scores for (1) patent A, claim X dependent and independent part(s) vs. patent B, claim Y, independent part and (2) patent A, claim X dependent and independent part(s) vs. patent B, claim Y, dependent and independent part(s) generate an **aggregate matching (or similarity) score** for patent A, claim X vs. patent B, claim Y." (note: emphasis added). The similarity score for comparing two patents is found in other locations of the Snyder reference, such as at column 17, lines 66-67: "...where a score indicates the **relative similarity** between two claims." (note: emphasis added).

The claim breadth metrics of applicants' invention are significantly different than the Snyder reference's similarity score. For example, because applicants' claim breadth metrics are automatically generated, a user can see what claims of theirs are narrow and thus may be ripe for discontinuing the payment of maintenance fees. A user can also see what claims of theirs are broad and thus more likely to be asserted against competitors. A portfolio's average claim breadth metric may also be calculated based upon the claim breadth metrics, and may be of interest to a user in evaluating the overall breadth and quality of claims that the user's company is

receiving (see Figure 29 of the patent application). Knowing the similarity scores as disclosed in the Snyder reference would not allow a user to accomplish the aforementioned examples. For this and other reasons, the Snyder reference does not read upon nor render obvious claim 1 or any of the other claims which recite claim breadth metrics.

Claim 11 has also been amended along similar lines, to recite that the text of multiple · claims is retrieved and automatically analyzed. It is submitted that claim 11 now also fully distinguishes over the references of record.

Claim 8 is also allowable over the Snyder reference. Claim 8 is directed to mapping patents or their parts to categories that are not derived by a computer system, but rather come · from a user (such as a client or an attorney). In this way, the user-prescribed categories are familiar to the audience that will be reviewing the results of the analysis. Contrary to this approach, the Snyder reference does not disclose user-prescribed categories. For example, *assuming arguendo* that categories are shown in Figure 9C of the Snyder reference, such categories are derived by the computer system and not by the user. In the Snyder reference, the user may not understand what the categories mean as the user had not prescribed them. For this and other reasons, claim 8 is allowable over the cited reference.

With regard to claim 23, that claim has been amended to include the recitations of cancelled claim 25. The references cited by the Examiner do not teach or suggest use of an eigenspace according to Applicants' invention. In the Applicants' invention, a population of training claims are used to define an eigenspace having a predefined category associated with each training claim. This eigenspace is then used by projecting claim text information to be analyzed (such as a new claim from a different patent or application) into the eigenspace. In this way the new claim can be associated with a category corresponding to the category to which it is closest within the eigenspace. The references of record do nothing like this.

In view of the amendment to claim 23, by inclusion of the language from claim 25, it is respectfully submitted that claim 23 is fully allowable over the references.
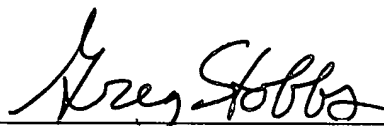
Drawings

The Applicants note that this application was filed with informal drawings. Applicants are currently in process of having formal drawings prepared. As soon as those are completed they will be forwarded to the Examiner for approval and filing in the application.

Conclusion:

In view of the foregoing, it is respectfully submitted that this application is now in a condition for allowance. Allowance is therefore courteously solicited at this time.

Should the Examiner wish to discuss any matters relating to this Amendment, or relating to the present application, the Examiner is respectfully encouraged to call the undersigned at 248-641-1600.

Respectfully submitted,

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ATTACHMENT OF CLAIMS

1. (Twice Amended) A computer-implemented patent portfolio analysis method comprising:

retrieving a corpus of patent information from a database, said patent information including multiple claims from a plurality of patent documents~~the claim text of at least one claim~~;

automatically determining claim breadth metrics for the multiple claims;

~~analyzing the claim text of said at least one claim to generate a claim breadth metric corresponding individually to said at least one claim;~~

associating ~~said~~ a claim breadth metric with ~~said~~ a claim ~~text~~ and storing said associated claim breadth metric in a computer-readable dataset,

wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is.

8. (Twice Amended) A computer-implemented patent portfolio analysis method comprising:

providing user-prescribed categories which were specified by a user;

retrieving a corpus of patent information from a database, wherein the patent information is information from multiple patent documents;

analyzing said patent information to generate a category metric corresponding to user-prescribed categories; and

associating said category metric with said patent information and storing said associated metric in a computer-readable dataset.

11. A computer-implemented patent portfolio analysis method comprising:

retrieving text of <u>multiple</u> claims from a computer-implemented data store, wherein the text of claims are from a plurality of patent documents;

<u>automatically</u> analyzing the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric <u>that is associated with a claim</u> is indicative of <u>how broad the claim is</u> [claim breadth of a claim],

wherein the claim breadth metrics are used to analyze the <u>multiple</u> claims.

23.   A computer-implemented patent portfolio analysis method comprising:

retrieving patent information from a database, wherein the patent information is from a plurality of patent documents;

analyzing said patent information to generate category metrics; and

associating said category metrics with said patent documents and storing said associated metrics in a computer-readable dataset,

<u>wherein said patent information includes claim text information to be analyzed and wherein said analyzing step includes:</u>

<u>defining an eigenspace representing a training population of training claims each training claim having associated training text;</u>

<u>representing at least a portion of said training claims in said eigenspace and associating a predefined category with each training claim in said eigenspace; and</u>

<u>projecting the claim text information to be analyzed into said eigenspace and associating with said projected claim text the predefined category of the training claim to which it is closest within the eigenspace.</u>

Please cancel claim 25.

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31. A computer-implemented patent portfolio analysis apparatus comprising:

a database of patent documents containing text of claims;

a claim breadth analysis module that <u>automatically</u> analyzes the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the claim breadth metrics are provided over an internet network for use in analyzing scope of the claims;

a cluster generator that analyzes patent information to generate category metrics for the patent documents, wherein clusters of patent documents are determined based upon the generated category metrics, wherein the clusters of patent documents are provided over an internet network for use in analyzing the patent documents.

32. A computer-implemented patent portfolio analysis method comprising:

retrieving a corpus of patent information from a database, said <u>patent</u> information including the claim text of a plurality of claims;

<u>automatically</u> analyzing the claim text of said plurality of claims to generate and associate an individual claim breadth metric with each of said plurality of claims.